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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,515	11/29/2001	Peter J. Armbruster	IR105459	5017

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MOTOROLA, INC.
CORPORATE LAW DEPARTMENT
SUITE R3163 PO BOX 10219
SCOTTSDALE, AZ 85271-0219

EXAMINER

PEACHES, RANDY

ART UNIT PAPER NUMBER

2686

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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DEC 07 2004

Technology Center 2600

Office Action Summary

Application No.

09/997,515

Applicant(s)

ARMBRUSTER ET AL.

Examiner

Randy Peaches

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/27/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 1-8, 11-17, and 20*** are rejected under 35 U.S.C. 102(e) as being anticipated by Gentry (U.S. Patent Number 6,453,162 B1).

Regarding ***claims 1 and 11***, Gentry discloses arrangement for services in a foreign network (16) by a user of a home network (10) comprising:

- ***a home network including a home location register (HLR, 17) coupled to the communication network. See column 4 lines 20-40 and FIGURE 2.***
- a personal computer (48) coupled to a WEB server (44), which reads on claimed "distributed home location register (DHLR)", including data for authorizing the services in the foreign network (16). See columns 5 and 6 lines 22-42 lines 24-27;

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- the said foreign network (16) including a wireless component (20), e.g. visitor location register (VLR, 20)(see column 6 lines 10-13), for determining an agreement for the services that are needed by the user in the said foreign network (16). See FIGURE 1, columns 4 and 5 lines 51-67 lines 1-4, respectively; and
- a subscriber station (12) which reads on claimed "mobile device", of the user coupled to the said foreign network (16) for approving the agreement for the services; See column 6 and 7 lines 55-67 lines 1-13.
- a communication network for coupling the said personal computer (48) to the said wireless component (20). See columns 6 lines 10-30 and FIGURE 2.

Regarding **claims 2 and 12**, according to **claims 1 and 11**, Gentry discloses in column 5 lines 29-32, wherein the said personal computer (48) is not located at the telecommunication service provider.

Regarding **claims 3 and 13**, according to **claim 2 and 12**, wherein, as disclosed by Gentry in column 3 lines 63-64, wireless subscribers, which reads on claimed "plurality of users", each said user of the said wireless subscribers having a said personal computer (48) coupled to a said WEB server (44) indicating the services available to the said user.

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Regarding **claims 4 and 14**, according to **claims 3 and 13**, wherein Gentry discloses that the home network includes a HLR (17) which receives a point code from a wireless data server (42), that retrospectively, received a request from the said personal computer (48) containing instructions for a feature change/update. See column 7 lines 48-62.

Regarding **claims 5 and 15**, according to **claims 1 and 11**, wherein Gentry discloses in column 5 lines 20-24, the said foreign network (16) includes a said HLR (17) for generating a message requesting approval of the agreement by the said personal computer (48). See column 5 lines 54-67 and FIGURE 3.

Regarding **claim 6**, according to **claim 1**, wherein, as disclosed by Gentry in column 5 lines 43-67, a said personal computer (48) includes a WEB server (44), which reads on claimed "mean", for generating an IS-41 messages, which reads on claimed "message", requesting the approval of the agreement by the subscriber station (12) of the user.

Regarding **claims 7 and 16**, according to **claims 1 and 11**, wherein, as taught by Gentry in column 5 lines 22-42, the said personal computer (48) coupled to the said WEB server (44) includes a computing device.

Regarding **claims 8 and 17**, according to **claims 1 and 11**, as disclosed by Gentry in column 6 lines 10-30, wherein the communication network includes an

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internet connection between the said personal computer (48) and the remote wireless component (20), which reads on claimed "VLR" (see column 6 lines 10-13).

Regarding **claim 20**, Gentry discloses in column 6 lines 32-65, of a roaming service agreement performed by a user of a subscriber unit (12) in a foreign network (16) comprising:

- pre-arranged roaming services agreement between the user and the foreign network (16). See column 6 lines 34-38;
- requesting an approval for roaming services by the foreign network. See column 6 lines 37-44;
- and approving by the user the roaming services. See column 6 lines 47-51, 60-65.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims **9-10 and 18-19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry (U.S. Patent Number 6,453,162 B1).

Regarding **claims 9-10 and 18-19**, according to **claim 1 and 11**, Gentry teaches of a communication network where a said personal computer (48) is connected to a said wireless component (20) of a said foreign network via the internet. Gentry, does not expressly disclose having a wireless or wire line connection between the VLR and the DHLR as claimed.

The examiner takes official notice that using the wireless or wire line connection to communicate between a mobile subscriber and a network component is well known in the art of telecommunications.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a wireless or wire line connection in Gentry in order to have a flexible way of implementing a transmission medium between the personal computer (48) and the said wireless component (20).

Response to Arguments

1. Applicant's arguments filed 07/27/2004 have been fully considered but they are not persuasive.

Per the above rejection regarding Applicant's amended **claims 1 and 11**, the Examiner concludes that the cited prior art reference of Gentry continues to disclose in the referenced column that the amended home network includes a

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HLR coupled to the said communication network. Therefore, per the Applicant's arguments the cited language thusly satisfies the claimed language.

Additionally, due to the above Examiner's statements, **claims 2-10 and 12-20** stands fully rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (703) 305-8993. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-

4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches
November 15, 2004

Marsha D. Banks-Harold
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